

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Karl Robert Pfleger et al. Art Unit : 2165
Patent No. : 7,925,657 Examiner : Christyann R. Pulliam
Issue Date : April 12, 2011 Conf. No. : 4198
Serial No. : 10/802,958
Filed : March 17, 2004
Title : METHODS AND SYSTEMS FOR ADJUSTING A SCORING MEASURE
 BASED ON QUERY BREADTH

Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1,504 days to 1,885 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency. “C Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(C). Patentees respectfully submit that the Office did not apply the proper standard for determining the period of B Delay under 35 U.S.C. § 154(b)(1)(B).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

Applicant Delay

A reply to a Notice to File Missing Parts was due on or before November 10, 2004 (the date that is three months after August 10, 2004, the date on which the Notice to File Missing Parts was mailed). Patentees filed a response to the Notice to File Missing Parts on February 10, 2005, thereby according an Applicant Delay of 92 days. Patentees do not dispute the PTO’s calculation for this Applicant Delay from November 11, 2004 (the day after the date that is three months after the date on which the Notice to File Missing Parts was mailed), to February 10, 2005. See 37 C.F.R. § 1.704(b).

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: June 09, 2011.

A reply to an Office Action was due on or before April 18, 2007 (the date that is three months after January 18, 2007, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on April 23, 2007, thereby according an Applicant Delay of 5 days. Patentees do not dispute the PTO's calculation for this Applicant Delay from April 19, 2007 (the day after the date that is three months after the date on which the Office Action was mailed), to April 23, 2007. See 37 C.F.R. § 1.704(b).

Patentees filed a Supplemental Reply on August 17, 2010, subsequent to a reply filed on August 9, 2010. Patentees were accorded 0 days delay for a supplemental response. In good faith and candor, Patentees submit that the supplemental response should have been accorded a total Applicant Delay of 8 days for delay from August 10, 2010, to August 17, 2010. See 37 C.F.R. § 1.704(c)(8).

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 105 days (i.e., the sum of 92 days, 5 days, and 8 days).

A Delay

A first PTO action was due on or before May 17, 2005 (the date that is fourteen months after March 17, 2004, the date on which the application was filed). The PTO mailed the first non-final Office Action on January 18, 2007, thereby according a PTO Delay of 611 days. Patentees do not dispute the PTO's calculation for this A Delay from May 18, 2005 (the day after the date that is fourteen months after the date on which the application was filed), to January 18, 2007. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1).

In view of the period of A Delay detailed above, the total A Delay for this patent should be calculated as 611 days.

B Delay

There is no dispute that the Office failed to issue a patent within three years of the filing date of the application and that Patentees are entitled to B Delay to compensate for that Office delay. The only issue in contention is the correct length of the B Delay period.

The period beginning on March 17, 2007 (the day after the date that is three years after the date on which the application was filed), and ending April 12, 2011 (the date the patent was

issued), is 1,487 days in length. The "PTA 36 Months" entry in the PAIR/PALM system indicates that a total of 0 days were awarded for B Delay for this patent. Patentees respectfully submit that the PTO's calculation of this B Delay is incorrect.

When Does "B Delay" Occur

As outlined in Wyeth v. Kappos, 93 U.S.P.Q. 2d 1257 (Fed. Cir. Jan. 7, 2010, affirming Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008)), the period of B Delay begins on the day after the date that is three years from the filing of the application and concludes upon the issuance of the patent:

Correspondingly, a violation of the B guarantee—the one at the heart of the issue in this case—begins when the PTO fails "to issue a patent within 3 years after the actual filing date of the application in the United States" Id. § 154(b)(1)(B). It ends when "the patent is issued." Id. The "period of delay" under the express language of the B clause therefore runs from the three-year mark after filing until the application issues.

Id.

The USPTO Incorrectly Determined the Dates on Which B Delay Occurred and the Resulting Overlap Between A Delay, B Delay, and C Delay

B Delay, prior to any potential exclusion under 35 USC 154(b)(1)(B), accumulated for a period beginning on March 18, 2007 (the day after the date that is three years after the date on which the application was filed), and ending April 12, 2011 (the date the patent was issued). The USPTO applied 35 USC 154(b)(1)(B) to exclude from B Delay a number of days that does not correspond to the period under which B Delay accumulated.

In assessing the overlap of A Delay, B Delay, and C Delay, there must be an understanding of the exact dates on which each of the periods of delay occurred so that any calendar dates on which A Delay, B Delay, and C Delay, occurred are not double counted (see Wyeth v. Kappos, holding that no overlap occurs unless A Delay and B Delay occur on the same calendar day). For the present patent, the USPTO has altered the period of B Delay in a manner that does not reflect the dates on which the relevant events occurred. Instead of measuring B Delay as beginning on March 18, 2007 (the day after the date that is three years after the date on which the application was filed), the USPTO has created a fiction that has B Delay beginning

later. As a result, the USPTO has concluded that B Delay did not accrue from March 18, 2007, to April 12, 2011 (even though no event has been alleged to have occurred during that time that would have prevented the running of the B Delay clock for the entire period).

The USPTO's methodology of creating an altered start date for B Delay that does not reflect when the delay actually occurred defies common sense and finds no support in 35 USC 154(b)(1)(B). Moreover, the construction of such a fictitious B Delay period is inconsistent with the admonition by the Federal Circuit in Wyeth v. Kappos that the USPTO should follow actual calendar events to determine when overlap occurs and not create fictitious periods of overlap that are inconsistent with calendar days (see Wyeth v. Kappos, rejecting the USPTO's "strained interpretation" of when B Delay occurs and affirming the importance of precise calendar days to conclude that "[i]f an A delay occurs on one day and a B delay occurs on a different day, those two days do not 'overlap' under section 154(b)(2)").

Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay "any time consumed by continued examination of the application." In the present matter, Requests for Continued Examination were filed on August 17, 2010, and November 17, 2010. The Director erred in the calculation of patent term adjustment by subtracting from B Delay a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice of Allowance on December 3, 2010, thereby closing examination of the application on that date. Thus, no continued examination took place during the 131 day period from December 3, 2010 (the mailing date of the Notice of Allowance), until April 12, 2011 (the date the patent was issued). Accordingly, 131 days of B Delay should have been included in addition to the 0 days accorded by the Director.

In the instant case, B Delay should be calculated as 1,379 days, the period of time from March 18, 2007 (the day after the date that is three years after the date on which the application was filed), to August 17, 2010 (the date on which a Request for Continued Examination was first filed), and December 3, 2010 (the mailing date of the Notice of Allowance), until April 12, 2011 (the date the patent was issued).

C Delay

The PTO mailed a Board of Patent Appeals and Interferences decision affirming-in-part the Examiner on June 18, 2010. Patentees filed a Notice of Appeal on October 3, 2007, thereby according a PTO Delay of 990 days. Patentees do not dispute the PTO's calculation for this PTO Delay from October 3, 2007 (the day the Notice of Appeal was filed), to July 29, 2010 (the day on which the Board of Patent Appeals and Interferences decision was mailed).

See 37 C.F.R. §1.703(e).

In view of the period of C Delay detailed above, the total C Delay for this patent should be calculated as 990 days.

Overlap of "A Delay" "B Delay" and "C Delay"

As detailed above, 611 days of A Delay accumulated during the following period:

May 18, 2005, to January 18, 2007.

As detailed above, 1,379 days of B Delay accumulated during the following periods:

March 18, 2007, to August 17, 2010; and

December 3, 2010, to April 12, 2011.

As detailed above, 990 days of C Delay accumulated during the following period:

October 3, 2007, to July 29, 2010.

As such, the periods of A Delay, B Delay, and C Delay overlap (i.e., occur on the same calendar day) for a total of 990 days, from October 3, 2007, to July 29, 2010.

Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1,504 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1,990 days (i.e., the sum of 611 days of A Delay, 1,379 days of B Delay, and 990 days of C Delay, minus 990 days overlapping delay);

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- 2) Total Applicant Delay should be calculated as 105 days; and
- 3) Total PTA should be calculated as 1,885 days.

The \$200 fee required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other credits or charges to Deposit Account No. 06-1050, referencing Attorney Docket No. 16113-0326001.

Respectfully submitted,

Date: June 9, 2011

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